

## REMARKS

### The Invention

The present invention relates to a method and apparatus for dynamically creating group addresses for facilitating communications among a group of users. More specifically, the present invention provides for methods and an apparatus for facilitating dynamic group creation for push-to-talk over Cellular (PoC) group communication sessions, instant messaging sessions, chat, and other communications. In one embodiment, the method comprises receiving at least one rule defining a member of the dynamic group in association with a group address and populating the dynamic group with members from the mobile stations determined in accordance with the at least one rule. Rules may be defined with reference to presence and/or location information available for the mobile stations. Such information may be published on behalf of the stations to one or more servers adapted to identify mobile stations matching the rules. The method may comprise subscribing to the servers to obtain the matching mobile stations with which to populate dynamic group addresses. These and other aspects, including one or more method, server, mobile station, and computer program product, will be apparent to those of ordinary skill in the art.

### Status of the Claims

Claims 65-117 are pending in the application.

Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114, and 116 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348).

Claims 72 and 73 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Dorot* (WO 2001/097539).

Claims 76-78 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Griffin et al.* (U.S. Patent No. 7,072,941).

Claim 85 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S.

Patent Publication No. 2004/0002348) and further in view of *Laiho* (U.S. Patent No. 6,097,942).

Claim 86 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Chandhok et al.* (U.S. Patent Publication No. 2004/0198376).

Claims 89-92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Leigh et al.* (U.S. Patent No. 5,535,426).

Claim 93 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Reguena* (U.S. Patent Publication No. 2002/0126701).

Claims 94-102 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348).

Claims 103-112 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) and further in view of *Dorot* (WO 2001/097539).

Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110,

113, 114 and 116; Rejected under 35 U.S.C. § 103(a)

Claims 65-71, 74, 75, 79-81, 83, 84, 86, 87, 94-100, 103-110, 113, 114 and 116 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Torvinen* (U.S. Patent Publication No. 2005/0113123) (hereinafter “*Torvinen*”) in view of *Fraccaroli* (U.S. Patent Publication No. 2004/0002348) (hereinafter “*Fraccaroli*”). *Torvinen* is concerned primarily with group formation and with location information. As stated in Applicants’ previous reply, *Torvinen* describes a method and system for organizing a group session between members based on their location or proximity and the technical capabilities considered to be necessary to engage in the group session, as determined by the organizing terminal. While *Torvinen* makes brief reference to presence servers, *Torvinen* does not teach or suggest using presence information to dynamically

create a group for a group communication session. At page 3 of the Office Action, dated December 4, 2006, the Examiner admits that *Torvinen* does not disclose publishing information about one or more particular users of respective mobile stations to the communications network.

*Fraccaroli*, on the other hand, is concerned with a wireless communications network comprising a server in a central location storing matching profiles for a plurality of users of the network. The user enters his matching profile using a WEB page, and the matching profile is then stored on a server for later use. In the normal course of events, the matching profile need only be entered once (see, for example, Paragraph 0055). Each matching profile corresponds with a respective mobile unit using the same identification information (ID) of the respective mobile unit utilized for carrying out phone calls. The server has a customizable variable matching algorithm and probes the matching profiles corresponding to the respective mobile units in a cellular telephone phone or group of cellular telephone phone for a match when a new cellular unit subscribes into the cell or group of cells. When there is a match of matching profiles, the two persons are advised of each other and they may then initiate a telephone call to contact each other if they wish (see, for example, Paragraph 0057).

There are multiple deficiencies in the Examiner's rejections set forth on pages 3-9 of the Office Action, dated June 18, 2007. That is, the cited art does not disclose what the Examiner states it discloses, *Fraccaroli* is non-analogous art, and even if *Fraccaroli* was combinable with *Torvinen*, such a combination does not disclose all the elements recited in the claims of the present application, and the Examiner has not properly supported the rejection under the standard set forth in *KSR International Co. v. Teleflex Inc.*, \_\_\_ U.S. \_\_\_, \_\_\_, 2007 WL 1237837 (2007).

With regard to the first point, the Examiner states that *Fraccaroli* teaches, in an analogous art, a method of creating and managing a group of mobile stations for a communication session in a communications network and publishing information about one or more particular users of respective mobile stations to the communications network. The Examiner cites Paragraph 0005 to support this position.

Paragraph 0005 of *Fraccaroli* is reproduced below:

Several methods and systems currently exist for generally matching people having similar interests or other reason for

willing to be put in contact with each other. For example, computer dating services match people using a large database having a profile for each one of their customers. Each customer's profile contains personal information such as age, race, marital status, gender, sexual orientation, religion, height, weight, color of eyes and/or hair, smoking habits, education, interests, etc. This matching profile is used to match the customer with others. In addition to their own matching profile, each customer can also submit a request which contains their preferences for a match with the matching profiles of other customers. In response to the request, the computer dating service searches the database for matching profiles which match the preferences in the request and then informs the requesting customer of the selected matches, if any. The match is typically recorded by some sort of a printed report.

With respect, Paragraph 0005 of *Fraccaroli* does not teach or suggest any of what the Examiner states. Paragraph 0005 does not discuss a method of any sort for creating and managing a group of mobile stations for a communication session. Paragraph 0005 neither mentions a communications network, nor discusses publishing information about one or more particular users of respective mobile stations to the communications network. Paragraph 0005 simply recites, at a high level, the workings of a conventional computer matching service.

With regard to the second point, it is noted that MPEP § 2141.01(a) states, “[i]n order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention is concerned.” *Id.*, citing, *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir 1992). Analogous fields in the electrical arts are not broad categories. For example, it has been held that similar, or even identical components, may be used in different manners and that art that relates to a component in one environment may not be used as a prior art reference under 35 U.S.C. § 103(a) in relation to the same type of component used in a different environment. That is, as set forth in MPEP § 2141.01(a) V., a reference relating to single, in-line memory modules (SIMMs) for industrial use was held not to be analogous prior art for an invention relating to SIMMS in personal computers. *Id.*, citing, *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993).

*Fraccaroli* discloses a matching mechanism, where two people are matched and provided with contact information for each other based on a saved matching profile when they happen to be located in the same cellular cell. *Fraccaroli* does not

concern group formation. There would be no motivation for one skilled in the art reviewing the teachings of *Torvinen*, which concerns a method and system for organizing a group session between members based on their location or proximity and the technical capabilities considered to be necessary to engage in the group session as determined by the organizing terminal, to modify the teachings of *Torvinen* with the teachings of *Fraccaroli*, which is a largely manual process for matching two individuals (not a group of individuals) and requiring the recipients to initiate contact with other. *Torvinen* is concerned with allowing the creator of a group or organizer of an event to flexibly create event/location-based services (Paragraph 0030). *Fraccaroli* does not meet this objective at all. Rather, in *Fraccaroli*, the HLR server of a cellular network may provide information to two subscribers allowing them to contact each other if it determined that a match exists, based on their locations and a previously-entered matching profile. Realistically, the system of *Fraccaroli* may not provide notifications to a user for days if no matches occur, which is a condition that entirely fails to meet the needs of the event/location-based services taught by *Torvinen*. In this respect, *Fraccaroli* and *Torvinen* substantially diverge and explicitly teach away from each other. If identical components used in different environments, e.g., SIMMs used in industrial setting vs. SIMMS used in personal computers, are considered “non-analogous,” it is without question that, based on the foregoing, *Fraccaroli* and *Torvinen* are non-analogous art.

Further, even if the cited art was combinable, *Fraccaroli* fails to cure the deficiencies of *Torvinen*. *Fraccaroli* concerns matching individuals based on a previously-entered, saved profile and then notifying those individuals of the match by providing information that allows the individuals to establish contact between themselves. In this sense, the method of *Fraccaroli* is akin to the automated matching (e.g., dating) service mentioned at Paragraph 0005, which aims to match people in pairs – not create groups having multiple members.

This is in direct contrast to the presently claimed subject matter, which recites a method comprising the steps of **publishing information about one or more particular users of respective mobile stations to the communications network, and receiving at least one rule for defining a member of a group.** The at least one rule is defined by criteria comprising published information about respective users of mobile stations and is received in association with a group address. In other words, as presently claimed, group membership and the rule for defining group

membership is dependent, at least in part, on the published information about the users of the mobile stations (*i.e.*, the published information is also published before group creation and is used to facilitate group creation). In contrast, *Fraccaroli* operates based on a saved matching profile, which is not published and is not associated with a group address, and the registration information of the cellular network to which the cellular phones of the users belong. No rules for defining the members of the group are received during the matching process of *Fraccaroli*. Therefore, even if *Fraccaroli* is properly combinable with *Torvinen*, which Applicants submit is not the case, *Fraccaroli* and *Torvinen* still fail to teach or suggest each and every feature recited in claim 65 of the present invention.

Further, with regard to the determination of obviousness under 35 U.S.C. § 103, the Supreme Court has recently stated that:

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, *it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does*. This is so because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. (Emphasis added.)

*KSR International Co. v. Teleflex Inc.*, \_\_\_ U.S. \_\_\_, \_\_\_, 2007 WL 1237837 (2007), (Slip Opinion at 14-15). In addition, the Supreme Court also noted that:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, *this analysis should be made explicit*. See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness*”). (Emphasis added.)

*Id.*, at \_\_\_ (Slip Opinion at 14). It is noted that the Supreme Court included an extended discussion reciting the nature of the inventions disclosed in the prior art and then several paragraphs identifying the rationale and reasons that the cited art could

be combined and why one skilled in the art would make such a combination. *Id.*, at \_\_\_\_ (Slip Opinion at 3-6, 20-22).

With regard to combining known elements of an invention, the Supreme Court further stated that, “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.*, at \_\_\_\_ (Slip Opinion at 14). This holding comports with *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), which held that although some of the cited references may individually have some of the claimed inventions’ features, “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.” *Id.* at 1075. Instead, to reach the proper conclusion under § 103:

the decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether...the claimed invention as a whole would have been obvious at *that time* to *that person*.

*Id.* at 1073-74.

The Examiner has not properly supported the rejection under 35 U.S.C. § 103(a) and under *KSR International*. At multiple locations in the Office Action, the Examiner identifies a first element in *Torvinen* and a second element in *Fraccaroli* and then states that these elements may be combined. For example, at page 3 of the June 18, 2007, Office Action, the Examiner states that, “*Torvinen* teaches a method of creating and managing a group of mobile stations for a communication session in a communications network ...” (emphasis added). On pages 3-4 of the of the June 18, 2007, Office Action, the Examiner states that, “*Fraccaroli* teaches ... publishing information about one or more particular users of respective mobile stations to the communications network.” (emphasis added). The Examiner then concluded that, “it would be obvious to one of ordinary skill in the art at the time of invention to use a method of creating and managing a group of mobile stations for a communication session in a communications network publishing information about one or more particular users of respective mobile stations to the communications network.” (emphasis added). Thus, the Examiner has merely identified selected elements, e.g. [X] and [Y], from the cited art, and stated that, “it would have been obvious to one of ordinary skill in the art at the time the

invention was made to use [X]/[Y].” Each specific rejection contains a similar conclusory sentence.

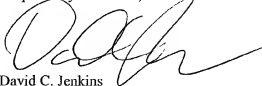
Applicants believe that such single conclusory sentences for each detailed rejection are not sufficient to qualify as an “articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness” and that the Examiner has failed to make the analysis explicit. Such an explicit analysis would be similar to the analysis provided by the Supreme Court in *KSR International*, which noted the elements in question and detailed how one skilled in the art would assemble, and even alter, these elements to arrive at the invention recited in the patent at issue. Moreover, the Court in *KSR International* specifically states that a mere conclusory statement cannot sustain a determination of obviousness.

Moreover, based on the description provided above, it can be seen that not only can these reference not be combined, *Torvinen* and *Fraccaroli* explicitly teach away from each other. Thus, there can be no reasonable expectation of success for one skilled in the art to use the teachings of *Torvinen* and *Fraccaroli* to arrive at the presently claimed subject matter. It is submitted that claim 65 recites patentable subject matter. Independent claims 94, 103, 104, 113, and 114 were also rejected on the same basis and are patentable for the same reasons. The remaining claims are dependent on claims 65, 94, 103, 104, 113, and 114 and are patentable for the same reasons.

#### CONCLUSION

In view of the above remarks, Applicants respectfully submit that the application is in proper form for issuance of a Notice of Allowance, and such action is requested at an early date.

Respectfully submitted,



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